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IN THE

Supreme Court of the United States

October Term, 1965

No. 433

McGRAW-EDISON COMPANY,

Petitioner,

vs.

PREFORMED LINE PRODUCTS COMPANY,

Respondent.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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SUBJECT INDEX

Page

Jurisdiction 2

Questions presented 2

Constitutional provision and statutes involved 4

Statement of the case 4

Reasons relied on for granting the writ 10

Argument 12

I.

Issues of great moment to the public are involved, and further litigation outside the Sixth Circuit which might result in conflict between circuit courts of appeal is improbable because respondent has obtained dismissal without trial of its complaint and petitioner's answer and counterclaim in the Ninth Circuit 12

II.

The judgments against petitioner are to be construed as holding that a defendant's rights can be decided by decree of another court in a summary proceeding in an action to which it is neither a party nor in privity, and deny petitioner its day in court, which is in conflict with decisions of the Supreme Court, and the due process clause of the Constitution 16

III.

The judgments of the courts below are in conflict with a decision of the Second Circuit, on an important point of federal law, on controlling facts which are parallel, and if the Supreme Court has not settled the law by its decision in Meccano, Ltd. v. John Wanamaker, supra, it should do so now 20

IV. Page

The judgments of the courts below sanction a departure so far from the accepted and usual course of judicial proceedings as to call for an exercise of the Supreme Court's power of supervision 22

Conclusion 24

APPENDIX:

Order Granting Plaintiff's Motion to Dismiss and Order Dismissing Defendant's Petition for Restraining Order and Dissolving Temporary Restraining Order .....App. p. 1

Judgment Nunc Pro Tunc of Dismissal Without Prejudice .....App. p. 3

Judgment .....App. p. 5

Opinion of United States Court of Appeals for the Ninth Circuit .....App. p. 6

Dismissal of Actions (Rule 41 F.R.C.P.) ....App. p. 17

Section 3 of Clayton Act (15 U.S.C. § 14)....App. p. 18

Declaratory Judgments Act (28 U.S.C. § 2201 and 2202) .....App. p. 18

Patent Act of 1952 (35 U.S.C. § 282) .....App. p. 19

Patent Act of 1952 (35 U.S.C. § 102(a)(b)(e)(f)-(g) .....App. p. 20

Uniform Commercial Code of California (§ 2312) .....App. p. 21

TABLE OF AUTHORITIES CITED

Cases	Page
Bechik Products, Inc. v. Flexible Products, Inc., et al., C.A. 2, 225 F. 2d 603, 106 U.S.P.Q. 340	24
Crosley Corp. v. Westinghouse Electric & Mfg. Co., C.A. 3, 130 F. 2d 474, 54 U.S.P.Q. 291	9
Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 86 L. Ed. 736, 62 S. Ct. 513	14
Hansberry v. Lee, 311 U.S. 32, 61 S. Ct. 115, 85 L. Ed. 22	18
Iron Cliffs Co. v. Negaunee Iron Co., 197 U.S. 463, 25 S. Ct. 474, 49 L. Ed. 836	18
Mackay Radio & Telegraph Co. v. Radio Corp. of America, 306 U.S. 86, 83 L. Ed. 506, 59 S. Ct. 427	14
Meccano, Ltd. v. John Wanamaker, 253 U.S. 136, 64 L. Ed. 822, 40 S. Ct. 463	17, 18, 22
Meccano, Ltd. v. John Wanamaker, 250 Fed. 250	20, 22
Mercoid v. Mid-Continent Investment Co., 320 U.S. 661, 88 L. Ed. 376, 64 S. Ct. 268	16
Muncie Gear Works v. Outboard Marine & Manufacturing Company, 315 U.S. 759, 86 L. Ed. 1171, 62 S. Ct. 865	14
Old Wayne Mutual Life Association v. McDonough, 204 U.S. 8, 51 L. Ed. 345, 27 S. Ct. 236	18
Postal Tel.-Cable Co. v. Newport, 247 U.S. 464, 62 L. Ed. 1215, 38 S. Ct. 566	16
Precision Instrument Mfg. Company v. Automatic Maintenance Machinery Co., 324 U.S. 806, 89 L. Ed. 1381, 65 S. Ct. 993	14

Page

Preformed Line Products Company v. The Fanner Manufacturing Co., N.D. Ohio, 225 F. Supp. 762, C.A. 6, 328 F. 2d 265, cert. den. 379, U.S. 846, 13 L. Ed. 2d 51 6

Preformed Line Products Company v. The Fanner Manufacturing Co., C.A. 6, 328 F. 2d 267 7

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 83 L. Ed. 34, 59 S. Ct. 8 14

The General Chemical Co. v. Standard Wholesale Phosphate etc., C.A. 4, 101 F. 2d 178, 40 U.S.P.Q. 258 23

Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp., ... U.S. ....., ..., L. Ed. 2d ....., ... S. Ct. ....., 147 U.S.P.Q. 404 16

Wenborne-Karpen Dryer Co. v. Dort Motor Car Co., C.A. 6, 14 F. 2d 378 24

Rules

Federal Rules of Civil Procedure, Rule 41(a)(2) 3, 4, 22, 23

Statutes

Clayton Act, Sec. 3 4

Uniform Commercial Code of California, Sec. 2312-(3) 4, 19

United States Code, Title 15, Sec. 14 4

United States Code, Title 28, Sec. 1254(1) 2

United States Code, Title 28, Sec. 1291 5

United States Code, Title 28, Sec. 1338(a) 4

United States Code, Title 28, Sec. 1400(b) 4

United States Code, Title 28, Sec. 2201 4

Page

United States Code, Title 28, Sec. 2202 4
United States Code, Title 35, Sec. 102(a) 4
United States Code, Title 35, Sec. 102(b) 4
United States Code, Title 35, Sec. 102(e) 4
United States Code, Title 35, Sec. 102(f) 4
United States Code, Title 35, Sec. 102(g) 4
United States Code, Title 35, Secs. 281-285 4
United States Code, Title 35, Sec. 282 4
United States Constitution, Fifth Amendment 4, 22

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PREFORMED LINE PRODUCTS COMPANY,

Respondent.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, McGraw-Edison Company, defendant-appellant below, respectfully prays that a writ of certiorari issue to review the Order of the United States District Court for the Southern District of California, Central Division [R. p. 225] and its Judgment *Nunc Pro Tunc* [R. p. 319], neither being reported, and the Judgment of the United States Court of Appeals for the Ninth Circuit [R. p. 386]. Copies of the Order and Judgments, and the Opinion of the Court of Appeals [R. p. 377], ... F. 2d .... (not published yet), 150 U.S.P.Q. 88, are printed in the Appendix hereto at App. 1, 3, 5, and 6, respectively.

Jurisdiction.

The judgment of the United States Court of Appeals for the Ninth Circuit was entered May 26, 1966. (No petition for rehearing was filed).

The jurisdiction of the Supreme Court is invoked under 28 U.S.C. § 1254(1).

Questions Presented.

1. Where a patent owner-manufacturer dominates a segment of the public utilities industry, and institutes and manipulates copending litigation to enforce the patent in two circuits against different defendants in a manner to achieve and retain the advantage of victory in one circuit establishing its patent monopoly and prevent, by dismissal over objection of the defendant in the other circuit, adjudication there of an answer and counterclaim, should not the Supreme Court of the United States order the suit in said other circuit restored to an active condition for trial particularly:

(a) when the question is one of great public moment,

(b) when conflict between circuits as to patent validity and infringement is rendered improbable,

(c) when the result is to prevent adjudication of charges of patent misuse and violation of the antitrust laws,

(d) when the defendant prevented from asserting its defenses and counterclaim is deprived of due process of law guaranteed by the Constitution of the United States,

(e) when the dismissal involves application of law which is in direct conflict with an applicable decision of

the Supreme Court and established law in another circuit,

(f) when the dismissal is contrary to the provisions of Rule 41(a) (2), Federal Rules of Civil Procedure,

(g) When the manipulation by the patentee includes a motion in the lawsuit in which the patentee was victorious, to hold in contempt the defendant in the other circuit and thus bar it from having its day in court?

2. Is not a purchaser of an article made by others entitled by due process of law and statute to maintain and try a declaratory judgment counterclaim charging invalidity, misuse and non-infringement of a patent when sued by the owner of the patent for patent infringement based on use and resale of the article, even though the patent owner later dismisses its complaint without prejudice and elects to pursue only a contempt action in a remote jurisdiction against the manufacturer of the article from whom the purchaser has been buying, particularly:

(a) when the purchaser is required by law to indemnify its own customers upon use and resale of the article which was found to infringe in the action against the manufacturer in said remote jurisdiction,

(b) when the purchaser is sought to be charged with contempt in said contempt action, to which it is not a party,

(c) when the purchaser charges misuse of the patent including the sale by the patentee of an unpatented element with an implied license to purchasers to complete the patented structure or combination, and that defense may not be availed of by the purchaser in said contempt action,

(d) when the purchaser seeks to establish its rights to manufacture the article itself, and

(e) when the purpose and effect of the dismissal by the patent owner are to secure and maintain for itself a monopoly of the article in a field in which the patent owner is already the predominant manufacturer?

Constitutional Provision and Statutes Involved.

The pertinent part of the Constitution of the United States involved is the Fifth Amendment set out below:

> "No person shall be * * * deprived of life, liberty, or property, without due process of law; * * *."

The statutory provisions involved are Rule 41(a)(2), Federal Rules of Civil Procedure, Section 3 of the Clayton Act (15 U.S.C. § 14), Declaratory Judgments Act (28 U.S.C. §§ 2201 and 2202), Sections of the Patent Act of 1952 (35 U.S.C. §§ 282 and 102(a)(b)-(e)(f)(g), and Uniform Commercial Code of California §2312(3). These statutory provisions are herein printed at App. 17, 18, 19, 20, and 21 respectively.

Statement of the Case.

Respondent-plaintiff, Preformed Line Products Company, filed its complaint [R. p. 13] May 1, 1958 against the City of Los Angeles, a municipal corporation, and petitioner-defendant, McGraw-Edison Company, a private corporation, charging infringement of U.S. Letters Patent No. 2,761,273, granted September 4, 1956, for "Dead-End for Cables". Jurisdiction in the District Court was conferred by 28 U.S.C. §§ 1338(a) and 1400(b), and 35 U.S.C. §§ 281-285.

Both defendants separately filed answers and counterclaims. As to the City of Los Angeles, disposition was made by a Stipulated Order filed June 15, 1964 [R. p. 47] dismissing without prejudice the complaint as to the City of Los Angeles and the latter's counterclaim for a declaratory judgment.

On February 24, 1965, the District Court, upon motion of Preformed, opposed by McGraw-Edison, dismissed without prejudice[1] both the complaint, and the petitioner-defendant's Second Amended and Supplemental Answer and Counterclaim [R. p. 136].

Appeal to the Court of Appeals for the Ninth Circuit was taken under 28 U.S.C. § 1291 by McGraw-Edison, and the judgment of the District Court was affirmed.[2]

While the case was pending in the District Court, the parties engaged in extensive discovery proceedings and motions of various kinds, and the case was off calendar by stipulation for a period of about three years.

At the time of the dismissal, the case was active, and on motion of McGraw-Edison Company the trial had been set to commence February 16, 1965.[3]

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[1]The Order of Dismissal is found at R. p. 225, is reproduced here, Appendix, page 1 and 2. A confirming judgment *nunc pro tunc* was entered as of February 24, 1965 [R. p. 319], and is reproduced at Appendix, page 3.

[2]The Opinion of the Court of Appeals, 150 U.S.P.Q. 88 not yet reported in the Federal Reporter, Second Series, at the writing of this petition, is found at R. p. 377, and is reproduced here at Appendix p. 6-17, the Judgment is at R. p. 386, and is here at Appendix p. 5.

[3]McGraw-Edison's Second Amended and Supplemental Answer and Counterclaim stood without reply when the case was dismissed, the District Court having granted a motion by McGraw-Edison to strike, with leave to Preformed to file an amended answer in the event the motion to dismiss was denied [R. p. 224(a)].

Reference is necessary to litigation, generally parallel in time, in the Sixth Circuit. Respondent, Preformed, on October 29, 1956, filed suit in the United States District Court for the Northern District of Ohio against The Fanner Manufacturing Company, among other things alleging infringement of Patent No. 2,761,273 referred to above.

Upon conclusion of the trial in 1959, the District Court in Ohio found the aforesaid patent was valid and infringed, but that Preformed had misused the patent and violated the antitrust laws of the United States and the patent was therefore unenforceable. The particular misuse found was Preformed's illegal tying of the purchase of armour rods to the purchase of the patented devices, and in exclusive dealing arrangements.

On May 17, 1962 the District Court in Ohio found and adjudged that the misuse of said patent had been purged, upon the passage of time alone without any showing of recompense and restoration to Fanner, and that Preformed was entitled to an injunction against further infringement and to damages for certain of the past infringment. *Preformed Line Products Company v. The Fanner Manufacturing Co.,* Northern District of Ohio, 1962, 225 F. Supp. 762. The judgment was affirmed by the Court of Appeals for the Sixth Circuit on February 19, 1964, 328 F. 2d 265, and rehearing was denied May 17, 1964. Certiorari was denied by the Supreme Court on October 12, 1964, 379 U.S. 846, 13 L. Ed. 2d 51.[4]

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[4]The only questions presented in Fanner's petition (Case No. 189, October Term, 1964) were as follows:

1. Should plaintiff's past misuse of Patent 2,761,273 involving illegal tying practices and exclusive dealing arrangements

Mr. Justice Douglas was of the opinion that certiorari should be granted.

In 1958, the assets of The Fanner Manufacturing Company were purchased by Textron Inc., Fanner was dissolved, and, Textron Inc, continued to make dead ends as The Fanner Manufacturing Company Division of Textron Inc.[5] After denial of the petition for writ of certiorari, Textron Inc. filed a declaratory judgment action against Preformed in the Northern District of Ohio [while the action in California was pending in the District Court], seeking adjudication of its rights with respect to a new form of dead end identified as the "Straight Bight Fanngrip".

After the filing of the declaratory judgment action by Textron Inc., Preformed filed motions in the original Ohio case to punish Textron Inc. and McGraw-Edison Company for contempt [R. pp. 185 and 189] in conspiring to violate the injunction issued by the Ohio court. No rule to show cause was issued. Instead the contempt motion as to Textron Inc. was treated in the nature of a complaint and Textron was directed by the court to file an answer, and the contempt proceedings were consolidated with the declaratory judgment action for trial. The parties to that suit are presently engaged in discovery proceedings.

The foregoing recitation identifies "the pending litigation in Cleveland, Ohio," referred to by the District Court in its Order of Dismissal [R. pp. 225, 226].

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have been found to be fully dissipated by the mere passage of time, without recompense and restoration?

2. Does plaintiff misuse Patent 2,761,273 by selling an *unpatented* element with an implied license to purchasers to complete the patented structure or combination? [this was a question not litigated in the Courts below.

[5]*Preformed Line Products Company v. The Fanner Manufacturing Co., supra,* at 328 F. 2d 267.

Upon representation to the District Court in California that McGraw-Edison had been named in the contempt motions in Ohio, and efforts made to compel its appearance, the District Court in California, on March 2, 1965, reinstated a temporary restraining order in the nature of an injunction to preserve the *status quo,* restraining Preformed until final decision on the appeal being taken to the Ninth Circuit Court of Appeals from proceeding directly or indirectly against McGraw-Edison in the contempt proceedings in Ohio [R. pp. 227-228]. The extension beyond the ten day period specified in Rule 65(b), and for the period of time specified in the restraining order, was consented to by Preformed [R. p. 316].

Under compulsion of the restraining order, and further proceedings in the district court in California based on the order [R. p. 237], Preformed temporarily suspended efforts to obtain the appearance of McGraw-Edison in response to the contempt motions in Ohio, and McGraw-Edison has not appeared therein. Now, in view of the affirmance by the Court of Appeals of the dismissal of the action in California, the protection afforded McGraw-Edison by the restraining order is no longer in effect, and Preformed has the way cleared to renew its attack against McGraw-Edison in said contempt proceedings in Ohio.

Returning now to the proceedings in California the Court of Appeals for the Ninth Circuit in affirming the District Court, stated "that if the case involved the dismissal of an independent action for declaratory judgment, rather than a counterclaim, the district court clearly would have discretion to dismiss by reason of the pendency of the Ohio case. Appellant does not ques-

tion this conclusion * * *". [App. p. 13]. Appellant (petitioner here) respectfully denies acquiescence in the quoted statement. Petitioner's position consistently has been that the pendency of the Ohio case could not be the basis for dismissal of a declaratory judgment action in any form by petitioner in California.[6]

The Court of Appeals' opinion states the law of the case to be that the issue of whether the Straight Bight Fanngrip infringes the patent "should first be determined in the Ohio court." The Court recognizes no other issue as present in the California case. Consequently, so long as the Ohio cases remain pending, McGraw-Edison is barred from litigating *any issues* tendered in its answer and counterclaim which was dismissed.

The Court's comment that since petitioner's "counterclaim for declaratory relief was dismissed without prejudice, McGraw-Edison Company may pursue any appropriate remedy it deems necessary," is a permissive suggestion which affords no relief to petitioner. Of what avail would it be to petitioner to file an independent action in any circuit for declaratory judgment on the same allegations? *Finality of the dismissal in the Ninth Circuit is obvious.* Relegation of the peti-

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[6]Petitioner's Opening Brief on Appeal contains the following statement on page 20: "In patent cases, the district courts may decline jurisdiction of a suit brought in good faith to obtain declaratory relief only if it appears that the *same parties* and issues are involved in another suit previously begun or that in another suit subsequently begun involving the *same parties* and issues the questions in controversy between the parties can be better settled and the relief sought by them more expeditiously and effectively afforded than in the declaratory proceeding." Citing *Crosley Corp. v. Westinghouse Electric & Mfg. Co.*, C.A. 3, 130 F. 2d 474, 54 U.S.P.Q. 291.

tioner solely to a defense in the contempt proceedings in Ohio, circumscribed by the restrictive rules of a contempt action, is not the appropriate remedy. The appropriate remedy open to petitioner in order to obtain a full determination of its rights, is this petition for writ of certiorari.

Reasons Relied on for Granting the Writ.

The writ of certiorari should be granted for the following reasons:

1. The judgments of the courts below terminating litigation which if proceeding to trial might result in a conflict of decisions as to validity and infringement of a patent are in conflict with decisions of the Supreme Court affirming such issues as of great moment to the public, and which should be tendered to this Court.

2. The judgments of the courts below prevent adjudication of charges that the patent owner has misused its patent, among other things, by selling an unpatented element with an implied license to purchasers to complete the patented structure or combination, and also prevent adjudication of charges that the patent owner has violated the antitrust laws.

3. The judgments of the courts below holding that a defendant's rights can be decided by decree of another court in a summary proceeding in an action to which he is neither a party nor in privity, and denying him his day in court, are in conflict with decisions of the Supreme Court to the contrary, and the due process clause of the Constitution.

4. The judgments of the courts below holding that a defendant's rights can be decided by decree of another court in a summary proceeding in an action to which he is neither a party nor in privity, and denying him his day in court, are in conflict with a decision in the Second Circuit on the same point of law involving important interpretations of federal law, and if the Supreme Court has not decided the question, it should do so.

5. The judgments of the courts below sanction a serious departure so far from the accepted and usual course of judicial proceedings, as to call for an exercise of the Supreme Court's power of supervision.

ARGUMENT.

I.

Issues of Great Moment to the Public Are Involved, and Further Litigation Outside the Sixth Circuit Which Might Result in Conflict Between Circuit Courts of Appeal Is Improbable Because Respondent Has Obtained Dismissal Without Trial of Its Complaint and Petitioner's Answer and Counterclaim in the Ninth Circuit.

Patent No. 2,761,273 relates to dead ends made up of a length of helically twisted wire, bent in the middle in the general form of a hairpin with a loop or bight to encircle a fixed anchor of some sort, and the end portions to be intertwisted around an electrical or other cable. The purpose is to transfer the anchoring load from the cable to the dead end.

The principal users throughout the nation are the public utilities in power transmission systems.

Respondent, Preformed, is admittedly the dominant manufacturer and seller in the United States of dead end devices which it alleges are protected by the patent. Its only competitor in the manufacture of such devices shown by the record is the Fanner Division of Textron. Preformed and Textron both have their manufacturing establishments for said dead end devices, and their offices, in Cleveland, Ohio. Petitioner, McGraw-Edison, engages in purchasing dead ends manufactured by Textron and reselling them to the public utilities. The purpose and effect of the dismissal of the action by the respondent are to secure and maintain its monopoly of dead end devices.

At a hearing in the District Court on September 24, 1964, Mr. Charles Prudell, general patent attorney for

McGraw-Edison, made the following statement [R. pp. 341-342]:

"Mr. Prudell: If it please the court, McGraw-Edison Company is being sued by Preformed, and to understand, we have a division in McGraw-Edison called the Line Material Industries, which for four years has served the industry with material to construct lines. It sold Preformed products until Preformed shut them out, and they were forced to go to Fanner to get them.

"This is a great part of our business, it is a significant part. We derive profit, which we pass on to the stockholders. In the utilities business the utilities demand two sources of supply to keep the prices down so they won't be criticized about their rates. If Preformed wins this case there will be one source of supply, Preformed.

"As Mr. Hume said, this is going to be determined in Cleveland, leaving Preformed a monopolist, and we will be out of business. We will lose this service which we have traditionally given to the utilities.

"If this is done, our management has authorized me this morning to pass on to your Honor that we plan to go into the manufacture, either directly or indirectly, of this straight bight grip, as in the opinion of our counsel and myself it does not infringe these patents, so we have direct plans.

"There is certainly a controversy between Preformed and McGraw-Edison. They are trying to shut off our service to the utilities."

Patent No. 2,761,273 having been held valid and infringed in the Sixth Circuit, rights of the public are involved in this litigation in the Ninth Circuit, and in view of the dismissal of petitioner's counterclaim, require the action of this Court for the protection of those rights.

> "The possession and assertion of patent rights are issues of great moment to the public."
>
> *Precision Instrument Mfg. Company v. Automatic Maintenance Machinery Co.*, 324 U.S. 806, 89 L. Ed. 1381, 65 S. Ct. 993.

Where the validity and infringement of a patent are in doubt and where it is improbable that conflict between Circuit Courts of Appeal will occur, due to the fact that only the litigants are engaged in competition thereon, certiorari will be granted.

> *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 89, 83 L. Ed. 506, 508, 59 S. Ct. 427.

Certiorari will be granted where the concentration of the industry to which the patent relates, in one circuit, makes litigation in other circuits resulting in a conflict of decision unlikely.

> *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 83 L. Ed. 34, 59 S. Ct. 8;
>
> *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 86 L. Ed. 736, 62 S. Ct. 513;
>
> *Muncie Gear Works v. Outboard Marine & Manufacturing Company*, 315 U.S. 759, 86 L. Ed. 1171, 62 S. Ct. 865.

Fanner was not in position to advance such grounds in its petition for writ of certiorari which was denied October 12, 1964,[7] because the case in the Ninth Circuit was not only pending in the District Court but had been set for trial to commence February 6, 1965.

Petitioner here, McGraw-Edison Company, is in a position to invoke its present grounds in view of the dismissal of its counterclaim on February 24, 1965, affirmed by the Court of Appeals of the Ninth Circuit. There is no other litigation pending involving the dead end patent, except that in Ohio, described above.

The principle involved in the cases cited is applicable to this petition which if granted can result in the Ninth Circuit case being reopened for trial, and a conflict of decisions being made probable, whereupon the validity and infringement of the patent could be brought before this Court.

Moreover, violation of the antitrust laws and patent misuse by respondent Preformed are asserted in this case. The charges are (a) selling its allegedly patented dead ends only to those agreeing to deal in Preformed's line of products exclusively; and (b) selling *unpatented* components which can be used in forming allegedly patented dead ends, with an implied license to its customers to complete the patented devices, thereby illegally extending the scope of the patent monopoly by restricting competition in the *unpatented* articles which it sells [R. pp. 138-140].

McGraw-Edison first asserted the stated misuse in its pleading lodged with a motion filed June 10, 1964 [R. pp. 31, 39, 43-44]. It was never pleaded nor

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[7] *Supra*, 379 U.S. 846, 13 L. Ed. 2d 51 (No. 189, October term, 1964).

tried in the original Ohio action, and appeared in that litigation for the first time as an unlitigated point in Fanner's petition for a writ of certiorari, *supra,* which nevertheless Mr. Justice Douglas was of the opinion should be granted.

In the instant case the charge stands undenied and is alone a strong reason why the Supreme Court should grant this writ. *Mercoid v. Mid-Continent Investment Co.,* 320 U.S. 661, 88 L. Ed. 376, 64 S. Ct. 268.[8]

II.

The Judgments Against Petitioner Are to Be Construed as Holding That a Defendant's Rights Can Be Decided by Decree of Another Court in a Summary Proceeding in an Action to Which It Is Neither a Party nor in Privity, and Deny Petitioner Its Day in Court, Which Is in Conflict With Decisions of the Supreme Court, and the Due Process Clause of the Constitution.

The question of whether McGraw-Edison may have any liability in the Cleveland Court on account of its sale of the Straight Bight Fanngrips (which have not been adjudicated) may be passed, as numerous other issues are tendered in McGraw-Edison's counterclaim.

Rather, attention is directed to the Supreme Court decisions which control as to whether McGraw-Edison is entitled to challenge the patent in issue irrespective of the Cleveland proceedings. The first decision for con-

[8]Since this case proceeded to judgment based solely upon the pleadings, other papers, and the motion to dismiss, with the Second Amended and Supplemental Answer and Counterclaim standing without reply, its allegations must be taken as true. *Postal Tel.-Cable Co. v. Newport,* 247 U.S. 464, 62 L. Ed. 1215, 38 S. Ct. 566; *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.,* ..... U.S. ....., ... L. Ed. 2d ....., ... S. Ct. ....., 147 U.S.P.Q. 404, 406.

sideration is *Meccano, Ltd. v. John Wanamaker,* 253 U.S. 136, 64 L. Ed. 822, 40 S. Ct. 463.

In that case a patent owner (Meccano) sued the manufacturer (Wagner) in the Sixth Circuit and the retailer of the Wagner toys (Wanamaker) in the Second Circuit. Meccano, in a summary proceeding against Wanamaker for an interlocutory injunction, based on a favorable decision in the Sixth Circuit against Wagner, moved also for a final decree upon the merits. The Supreme Court sustained the Court of Appeals for the Second Circuit in denying the motion for a final decree.

The Supreme Court's language is pertinent, 253 U.S. at 141-142, 64 L. Ed. at 826:

> "Petitioner maintains that its motion for final decree upon the merits should have been sustained. But the appeal was from an interlocutory order, and the court could only exercise powers given by statute. On such an appeal a cause may be dismissed if it clearly appears that no ground exists for equitable relief; but finally to decide a defendant's rights upon the mere statement of his adversary, although apparently supported by ex parte affidavits and decrees of other courts, is not within the purview of the act. He is entitled to a *day in court,* with opportunity to set up and establish his defenses. The motion for final judgment was properly overruled. Eagle Glass & Mfg. Co. v. Rowe, 245 U.S. 275, 281, 62 L. ed. 286, 289, 38 Sup. Ct. Rep. 80." (Emphasis added).

That decision is directly applicable to the case at bar. Dismissal of the action which included McGraw-Edison's Answer and Counterclaim was finally to decide McGraw-Edison's rights on the apparent support of the decree in the Sixth Circuit, and on the mere statements of its adversary Preformed as to issues still involved in proceedings there.

The judgments of the courts below in the Ninth Circuit are in direct conflict with the Supreme Court decision in the *Meccano* case.

It is also abundantly clear that the reason for the dismissal, "in light of * * * the pending litigation in Cleveland, Ohio," stated in the District Court's ruling [R. p. 225], and the effect of the language in the Court of Appeals affirmance, "We agree with appellee and the district court that no justiciable issue is created by McGraw-Edison's plan to manufacture dead-ends independently if Fanner is unsuccessful," is to enforce against McGraw-Edison Company, the judgment in the Ohio case. This includes sustaining of the validity of the patent as against McGraw-Edison, who is not and never was a party and has had no day in court.

This action by the courts below has been repeatedly held by this Court to be repugnant to rights guaranteed by the Constitution.

Hansberry v. Lee (1940), 311 U.S. 32, 61 S. Ct. 115, 85 L. Ed. 22;

Old Wayne Mutual Life Association v. McDonough (1907), 204 U.S. 8, 51 L. Ed. 345, 27 S. Ct. 236;

Iron Cliffs Co. v. Negaunee Iron Co. (1905), 197 U.S. 463, 25 S. Ct. 474, 49 L. Ed. 836.

The apparent reason for the Court of Appeals' affirmance of the dismissal of petitioner's counterclaim was to avoid what it considered a multiple litigation situation. The basis for the opinion is that *possibly* the Cleveland court in the trial on the straight bight grip may find there is no infringement. Even if this future event should occur, McGraw-Edison is still left with a finding of patent validity and infringement of at least one particular structure hanging over its head. It was respondent Preformed who chose to take up the cudgels against McGraw-Edison by initiating its suit for infringement against that company. Yet, despite the fact the Court of Appeals acknowledged that "McGraw-Edison is not bound by the Cleveland judgment and injunction" since it was neither a party nor in privity in the Ohio suit, the court, in affirming the dismissal of McGraw-Edison's counterclaim has for all practical purposes eliminated McGraw-Edison's right to contest, among other things, the validity of the patent.

This is quite significant since petitioner does, by statute, indemnify its customers to whom it resells the dead end devices.[9]

Petitioner certainly should be entitled to try the question of validity, misuse, etc. raised in its counterclaim in order to ascertain the liabilities it may incur as a result of its resale and use of dead ends supposedly infringed by a patent held to be valid in a suit in a remote jurisdiction to which petitioner, McGraw-Edison was neither a party nor in privity.

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[9]Uniform Commercial Code of California §2312(3) App. p. 21, also the law in other states.

III.

The Judgments of the Courts Below Are in Conflict With a Decision of the Second Circuit, on an Important Point of Federal Law, on Controlling Facts Which Are Parallel, and if the Supreme Court Has Not Settled the Law by Its Decision in Meccano, Ltd. v. John Wanamaker, supra, It Should do so Now.

The Second Circuit decision is *Meccano, Ltd. v. John Wanamaker,* 250 Fed. 250, the same case dealt with in the Supreme Court decision cited above.

The facts in *Meccano* are as summarized in petitioner's discussion under point II, supplemented as follows: The suit was for infringement of a patent, a copyright, and for unfair competition. Wagner, the manufacturer, who was sued in Ohio, had agreed to hold Wanamaker, who was sued in New York, harmless for any sales of the toys and manuals charged to infringe, and in pursuance of that undertaking he had "taken a share in the defense" of Wanamaker. Judge Learned Hand even assumed, for the purposes of Meccano's motion, that Wagner had assumed the chief conduct of the case.

In the Ohio case where Meccano had sued Wagner, the case proceeded through trial and appeal, and the patent was held invalid by the Court of Appeals but the copyright was sustained and held infringed and unfair competition was found to have occurred.

The motion before Judge Hand in New York was upon the record in the Ohio suit which was made a part of the moving papers. This motion, for judgment on the merits, was denied.

Judge Hand noted that Wanamaker's purchase of toys and manuals from Wagner, which he had been enjoined from selling, if not an actual contempt of that decree, was at least in derogation of the rights of the plaintiff established thereby, regardless of Wanamaker's personal right to sell toys and manuals, if bought from others, or to manufacture them itself and sell them without the cooperation of Wagner. He then said:

> "What we have before us is whether, conceding all this, the plaintiff has established, *or can* establish, in the Ohio suit, any estoppel which will generally conclude the defendant upon all the issues raised between itself and the plaintiff by the pleadings in this suit.
>
> "We think it clear that that decree cannot have any such effect * * * It is apparent that some of the issues are different than those litigated in Ohio; they involve, not only the right to sell Wagner's toys and manuals, but any others which it may procure elsewhere. We have no right to assume, because the defendant allows Wagner to have the chief conduct of the defense, that it has abandoned all rights, except that of getting the toys and manuals from him."

Summarized, the Second Circuit decision clearly defines the law to be, that one sued for infringement arising from his buying and selling the products of a manufacturer, who has been enjoined in another suit, has the right to his day in court in his own suit irrespective of any violation or tort he may commit by continuing to deal in the enjoined products.

The Ninth Circuit decision in the present case is in direct and irreconcilable conflict with the *Meccano* decision.

It goes to fundamental rights as guaranteed by the Fifth Amendment. McGraw-Edison's rights are being adversely affected without due process of law. If the Supreme Court affirmance of these rights in *Meccano, Ltd. v. John Wanamaker, supra,* (point II) did not settle the question, it should be settled now.

IV.

The Judgments of the Courts Below Sanction a Departure so Far From the Accepted and Usual Course of Judicial Proceedings as to Call for an Exercise of the Supreme Court's Power of Supervision.

The generally accepted principle for many years in patent cases has been that a defendant sued for infringement could "lock in" the issues for adjudication by filing a counterclaim for declaratory judgment on the questions of validity and infringement, which necessarily involves scope of the claims if valid.

This principle was recognized and implemented by Rule 41(a)(2), F.R.C.P., the pertinent part of which provides:

> By Order of Court. * * * If a counterclaim has been pleaded by a defendant prior to the service upon him of the plaintiff's motion to dismiss, the action shall not be dismissed against the defendant's objection unless the counterclaim can remain pending for independent adjudication by the court.

Independent "adjudication" is predicated on the defendant-counterclaimant having its *day in court.* There

is no discretion given to the court by this rule to dismiss the counterclaim over the defendant's objection. The phrase "can remain pending" must be defined as including *shall*. Otherwise the word "could" would have been substituted.

The counterclaim here "locked in" the issues for adjudication. Dismissal of the counterclaim was not on grounds of lack of jurisdiction or venue, not on *res judicata*, not on the merits—but in the light of another action partly resolved with finality, and partly pending. The parties in the two actions are not the same. This dismissal was not an *adjudication* as intended by Rule 41(a)(2).

Dismissal by the District Court of the declaratory judgment counterclaim, which had been pending for approximately seven years, and where pretrial discovery had been completed to a point that a trial date had been set, invoked the exercise of discretion where none was authorized. This was contrary to the rule, and a serious departure from the accepted and usual course of judicial proceedings. There was no exception to justify it.

The accepted and usual course of judicial proceedings is to recognize a clear right in a purchaser (customer) sued for infringement to defend himself fully regardless of what has been adjudicated against the manufacturer. See for example:

> *The General Chemical Co. v. Standard Wholesale Phosphate etc.*, C.A. 4, 101 F. 2d 178. 40 U.S.P.Q. 258;

Bechik Products, Inc. v. Flexible Products, Inc., et al., C.A. 2, 225 F. 2d 603, 106 U.S.P.Q. 340;

Wemborne-Karpen Dryer Co. v. Dort Motor Car Co., C.A. 6, 14 F. 2d 378, 379.

McGraw-Edison has been denied this right by the lower courts' departure from the accepted and usual course of judicial proceedings, affirmed by the Court of Appeals, as to call for an exercise of the Supreme Court's power of supervision.

Conclusion.

For the reasons stated, and under the Constitution, statutes, rules, and cases cited, the petition for writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX.

ORDER GRANTING PLAINTIFF'S MOTION TO DISMISS AND ORDER DISMISSING DEFENDANT'S PETITION FOR RESTRAINING ORDER AND DISSOLVING TEMPORARY RESTRAINING ORDER.

In the United States District Court Southern District of California, Central Division.

Preformed Line Products Company, a private corporation, Plaintiff, vs. McGraw-Edison Company, a private corporation. Defendant. No. 406-58 MC.

On January 22, 1965, plaintiff's motion to dismiss and defendant's order to show cause for temporary restraining order were argued and submitted for decision. The following counsel appeared for plaintiff: Richard Stevens, Patrick Hume, Richard Hamilton and Henry Brinks; and the following counsel appeared for defendant: Herbert A. Huebner, Harlan Huebner and Charles Prudell.

Rule 41 (a)(2) of the Federal Rules of Civil Procedure permits dismissal even though a counterclaim has been filed where, as here, the counterclaim can remain pending for independent adjudication by the court. Here, defendant's counterclaim is for declaratory relief and could remain pending; however, in light of the dismissal of the complaint and the pending litigation in Cleveland, Ohio, the counterclaim should also be dismissed without prejudice.

Plaintiff's motion to dismiss complaint and counterclaim is granted without prejudice and each party to bear his own costs.

Defendant's petition for restraining order is dismissed and the temporary restraining order is dissolved.

Dated: February 23, 1965.

/s/ M. D. CROCKER
United States District Judge

[Endorsed]: Filed and Entered February 24, 1965.

JUDGMENT NUNC PRO TUNC OF DISMISSAL WITHOUT PREJUDICE.

In the United States District Court, Southern District of California, Central Division.

Preformed Line Products Company, a private corporation, Plaintiff, vs. McGraw-Edison Company, a private corporation, Defendant. Civil Action No. 406-58-MC.

This matter having come on for hearing on plaintiff's motion to dismiss the action, including the action averred in the Complaint and the actions averred in the counterclaim contained in the Second Amended Supplemental Answer and Counterclaim, and the Court having made an Order among other things granting plaintiff's motion to dismiss the Complaint and said counterclaim without prejudice and each party to bear his own costs, said Order being filed and entered February 24, 1965, and the Court having intended by said Order to dispose of this case in its entirety as to all causes of action pleaded by the parties hereto, and each of them, and the defendant having appealed to the Court of Appeals for the Ninth Circuit from said Order, and both parties, through their respective counsel, Reginald E. Caughey, Esquire, for the plaintiff and Herbert A. Huebner, Esquire, for the defendant having represented to this Court that it is their joint desire to assure that the appeal may be presented in proper form for a decision on the merits presented by the appeal;

Now, Therefore, it is Ordered, Adjudged and Decreed, that

1. The Complaint and the action averred therein are dismissed without prejudice;

2. The counterclaim contained in the Second Amended Supplemental Answer and Counterclaim of McGraw-Edison Company, and the actions averred therein, are dismissed without prejudice;

3. The action herein in its entirety as to all causes of action pleaded by the parties, and each of them, is dismissed without prejudice;

4. Each party shall bear his own costs; and

5. This judgment shall be entered nunc pro tunc as of February 24, 1965.

Dated: May 10th, 1965.

/s/ M. D. Crocker
Judge

Approved as to form and substance:
Lyon & Lyon
Reginald E. Caughey
/s/ By Reginald E. Caughey
Attorneys for Plaintiff

Substance of the representations in the preamble approved, and the form in toto approved:
Huebner & Worrel
Herbert A. Huebner
Richard M. Worrel
Harlan P. Huebner
Albert L. Gabriel
Herbert A. Huebner
Attorneys for Defendant

[Endorsed]: Filed and Entered May 10, 1965.

Judgment.

United States Court of Appeals, for the Ninth Circuit.

McGraw-Edison Company, a corp., Appellant, vs. Preformed Line Products Company, a corp., Appellee. No. 20,023.

Appeal from the United States District Court for the Southern District of California, Central Division.

This Cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division and was duly submitted.

On Consideration Whereof, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is affirmed.

Filed and entered May 26, 1966.

Opinion of United States Court of Appeals for the Ninth Circuit.

United States Court of Appeals for the Ninth Circuit.

McGraw-Edison Company, a corporation, *Appellant*, vs. Preformed Line Products Company, a corporation, *Appellee*. No. 20,023.

[May 26, 1966]

On Appeal from the United States District Court for the Southern District of California, Central Division.

Before: Jertberg and Ely, Circuit Judges, and Jameson, District Judge.

Jameson, District Judge:

This is an appeal from an order dismissing, without prejudice, a complaint for patent infringement and a counterclaim for declaratory judgment.

The appellee, Preformed Line Products Company, filed a complaint on May 1, 1958, against the City of Los Angeles and appellant, McGraw-Edison Company, charging infringement of United States Letters Patent No. 2,761,273, granted September 4, 1956, for "Dead-End For Cables".[1] Both defendants filed answers and counterclaims.

A stipulation was filed June 15, 1964, dismissing without prejudice the complaint as to the City of Los Angeles and the City's counterclaim for a declaratory judgment. On February 24, 1965, the district court, upon motion of Preformed, opposed by McGraw-Edison, dismissed without prejudice both the complaint and appellant's counterclaim.

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[1]Jurisdiction in the district court was conferred by 28 U.S.C. 1338(a) and 1400(b) and 35 U.S.C. 281-285. This appeal was taken under 28 U.S.C. 1291.

Preformed, on October 29, 1956, had filed suit in the United States District Court for the Northern District of Ohio against The Fanner Manufacturing Company, alleging infringement of two patents and unfair competition. One of the patents charged to be infringed was No. 2,761,273 for "Dead-End For Cables". The instant action was brought by Preformed against the City of Los Angeles and McGraw-Edison alleging their use and sale, respectively, of dead ends made by The Fanner Manufacturing Company and charged to infringe Patent No. 2,761,273.

The Ohio case was tried in January-February, 1959. Although no decision in the Ohio action had been announced, the parties in this action stipulated on November 3, 1959, that the case should be removed from the trial calendar.[2]

By judgment dated May 17, 1962, the United States District Court for the Northern District of Ohio determined that the dead end patent was valid and infringed by Fanner and that Preformed was entitled to an injunction against further infringement and to damages for past infringement. Preformed Line Products Co. v. The Fanner Mfg. Co., N.D. Ohio 1962, 225 F. Supp. 762. The judgment was affirmed by the Court of Appeals for the Sixth Circuit on February 19, 1964, (328 F. 2d 265) and rehearing was denied May 17, 1964. Certiorari was denied by the Supreme Court on October 12, 1964. (379 U.S. 846)

[2]The order entered pursuant to the stipulation recited that the court had been "advised by counsel for both parties of the pendency of an action in the United States District Court for the Northern District of Ohio, Eastern Division, involving substantially the same issues and the fact that said case had been tried and was under submission and that the decision in said case might dispose of this action * * *".

This case remained off the calendar for about three years. Pursuant to a local court rule, it was then placed on the calendar for consideration of dismissal for want of prosecution. A hearing was held October 15, 1962. Upon representation to the court that the case in the Northern District of Ohio had been tried but that the plaintiff, Preformed Line Products Company, was required to purge itself of "unclean hands", which subsequently was held to have been accomplished, and that the case was then on appeal, the district court ordered that the order of November 3, 1959, would be continued in effect.

On April 15, 1964, McGraw-Edison filed a notice restoring the action to the trial calendar. Thereaftef McGraw-Edison filed a motion for leave to file an amended and supplemental answer and counterclaim. An order was entered June 25, 1964, granting McGraw-Edison's motion, subject to certain conditions and exceptions. On July 31, 1964, McGraw-Edison filed its first amended and supplemental answer and counterclaim.

Thereafter depositions were taken in Cleveland, Ohio. On September 16, 1964, McGraw-Edison filed a motion to compel answers to questions on oral depositions and a motion to set the case for trial. Preformed filed a motion to strike the fifth cause of defendant's counterclaim, which sought a declaratory judgment with respect to a modified device known as "Straight-Bight Fanngrip". On September 24, 1964, the court denied the motion to strike, granted defendant leave to file a second amended answer and counterclaim, and set the case for trial to commence February 6, 1965.

Preformed filed its answer to the counterclaim of McGraw-Edison as amended and supplemented, and on January 8, 1965, McGraw-Edison filed a motion to strike the answer. Shortly thereafter Preformed sought to have McGraw-Edison charged in contempt in the Ohio case. On January 15, 1965, the district court in this action granted an order to show cause and temporary restraining order restraining Preformed from proceeding against McGraw-Edison in the Ohio case.

On January 19, 1965, Preformed filed a motion to dismiss this action "on the ground that all justiciable matters and issues raised herein are presented in, and fully determinable by" the Ohio case. On February 24, 1965, the court granted Preformed's motion to dismiss its complaint without prejudice and also ordered dismissal without prejudice of the McGraw-Edison counterclaim. This order was supplemented by a nunc pro tunc order of May 10, 1965, dismissing the "action in its entirety".

The order of February 23, 1965, reads in pertinent part:

> "Rule 41(a)(2) of the Federal Rules of Civil Procedure permits dismissal even though a counterclaim has been filed where, as here, the counterclaim can remain pending for independent adjudication by the court. Here, defendant's counterclaim is for declaratory relief and could remain pending; however, in light of the dismissal of the complaint and the pending litigation in Cleveland, Ohio, the counterclaim should also be dismissed without prejudice.
>
> "Plaintiff's motion to dismiss complaint and counterclaim is granted without prejudice and each party to bear its own costs."

Rule 41(a)(2) F. R. Civ. P. provides in pertinent part: "* * * If a counterclaim has been pleaded by a defendant prior to the service upon him of the plaintiff's motion to dismiss, the action shall not be dismissed against the defendant's objection unless the counterclaim can remain pending for independent adjudication by the court. * * *"

The parties agree that McGraw-Edison's counterclaim could have remained pending for independent adjudication notwithstanding dismissal of the complaint. The dismissal of the complaint without prejudice accordingly was proper under Rule 41(a)(2). The question then arises as to whether the trial court could properly dismiss the counterclaim for declaratory relief. The answer to this question does not depend upon Rule 41(a)(2),[3] but rather upon a construction of the Federal Declaratory Judgment Act.

The Declaratory Judgment Act (28 U.S.C. 2201) provides that in "a case of actual controversy within its jurisdiction", a court may "declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought". Rule 57 of the Federal Rules of Civil Procedure provides, "The existence of another adequate remedy does not preclude a judgment for declaratory relief in cases where it is appropriate."[4]

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[3]Rule 41(a)(2) neither precluded nor required dismissal of the counterclaim since it could remain pending for independent adjudication.

[4]The note of the Advisory Committee on Rule 57 reads in part: "When declaratory relief will not be effective in settling the controversy, the court may decline to grant it." Notes of Advisory Committee on Rules, Rule 57, 28 U.S.C.A., at 568 (1960).

Professor Borchard has well stated the applicable rules for determining when declaratory relief is appropriate:

> "The two principal criteria guiding the policy in favor of rendering declaratory judgments are (1) when the judgment will serve a useful purpose in clarifying and settling the legal relations in issue, and (2) when it will terminate and afford relief from the uncertainty, insecurity, and controversy giving rise to the proceeding. It follows that when neither of these results can be accomplished, the court should decline to render the declaration prayed." Borchard, Declaratory Judgments 299 (2d ed. 1941).[5]

Ordinarily the question of whether a district court shall exercise jurisdiction in a declaratory judgment action rests in the sound discretion of that court. As this court said in Shell Oil Co. v. Frusetta, 1961, 290 F. 2d 689, 691-92:

> "It is well established that even though jurisdiction may exist under the Declaratory Judgment act the granting of declaratory judgments is at the discretion of the district court. (Citing cases.) Said discretion is to be exercised in accordance with sound judicial principles and the purposes of the Declaratory Judgment Act. * * * The purpose of the Declaratory Judgment Act is to afford an added remedy to one who is uncertain of his rights and who desires an early adjudication thereof with-

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[5]This statement from Borchard has been quoted with approval in many cases, including Maryland Casualty Co. v. Boyle Constr. Co., 4 Cir. 1941, 123 F.2d 558, 565; Delno v. Market St. Ry., 9 Cir. 1942, 124 F.2d 965, 968; and American Casualty Co. of Reading, Pa. v. Howard, 4 Cir. 1949, 173 F.2d 924, 928.

out having to wait until his adversary should decide to bring suit, and to act at his peril in the interim."

The bases for refusing declaratory relief were well summarized in Yellow Cab Co. v. City of Chicago, 7 Cal. 1951, 186 F.2d 946, 950-51, as follows:

> "The discretion of a court to entertain a suit for declaratory judgment is a 'judicial discretion' which must find its basis in sound reason * * * and jurisdiction is not to be declined merely because of the existence of another adequate legal remedy * * * or even because of the pendency of another suit, if the controversy between the parties is such that it will not necessarily be determined therein * * *. It is well settled, however, that a declaratory judgment may be refused where it would serve no useful purpose * * * or would not finally determine the rights of the parties * * * or where it is being sought merely to determine issues which are involved in a case already pending and can be properly disposed of therein * * * especially if the issue is one involving a novel question of state law * * * or is, for any other reason, one that can better be adjudicated in another court * * *. Nor should declaratory relief be granted where it would result in piecemeal trials of the various controversies presented or in the trial of a particular issue without resolving the entire controversy * * *." (Citations omitted as indicated by asterisks).

No one factor necessarily controls the court in determining whether it should entertain an action for declaratory judgment. Multiplicity of litigation, however, is al-

ways an important factor. As Professor Moore has well said:

> "The maintenance of separate actions involving the same issues should be discouraged. Where a declaratory action presents issues which would necessarily be settled by another pending state or federal action, the court should weigh the relative merits of each of the two actions *as of the time of the hearing on the motion to dismiss.* The decision on the motion to dismiss should be determined in the light of the purposes of the Act, and by the same principles that normally govern the exercise of judicial discretion in this field—whether a declaratory judgment would serve a useful purpose 'in clarifying and settling the legal relations in issue,' and whether it would 'terminate and afford relief from the uncertainty, insecurity, and controversy giving rise to the proceeding.'" 6 Moore, Federal Practice §57.08[6], at 3042 (2d ed. 1965).

We turn now to the application of these rules to the instant case. It may be noted at the outset that if the case involved the dismissal of an independent action for declaratory judgment, rather than a counterclaim, the district court clearly would have discretion to dismiss by reason of the pendency of the Ohio case. Appellant does not question this conclusion, but argues that in the posture of the entire proceedings in both courts, Preformed having filed both actions, with different defendants, the district court abused its discretion in dismissing the counterclaim. It further argues that the dismissal deprived appellant of due process of law.

As noted supra, the district court dismissed the counterclaim "in light of the dismissal of the complaint and the pending litigation in Cleveland." Both parties assume that the court accepted one or more of the reasons urged by appellee in its motion to dismiss:

> "1. Fanner and McGraw-Edison are acting in contempt of the United States District Court in Cleveland when they collaborate to maintain this action;
>
> "2. The determinations of said District Court as to Fanner products are binding upon McGraw-Edison;
>
> "3. The authorities, especially *E. B. Kaiser Co. v. Rick-Wil Co.*, 95 F.Supp. 54 (N.D. Ohio 1950) demonstrate that said District Court should be allowed to construe its own injunction;
>
> "4. No justiciable issue is created by McGraw-Edison's 'plan' to manufacture dead ends independently if Fanner is unsuccessful."

Prior to the dismissal of this action, Preformed filed motions in the Ohio case to punish Textron Inc.[6] and McGraw-Edison for contempt in conspiring to violate the judgment and injunction issued by the Ohio court. McGraw-Edison argues that it was not a party to the Ohio litigation, is not bound by the "Cleveland injunction", and that the case of E. B. Kaiser, Co. v. Rick-Wil Co. is inapposite since there the same parties were involved in actions instituted in Illinois and Ohio.

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[6]The Fanner Manufacturing Co. was the defendant in the Ohio case. Textron, Inc. is the successor in interest to Fanner. The Fanner Manufacturing Co. has been dissolved, and its business has been continued as Fanner Division of Textron, Inc. (Preformed Line Products Co. v. The Fanner Mfg. Co., supra, at 328 F.2d 267).

Appellee in effect concedes that McGraw-Edison is not bound by the Cleveland judgment and injunction. It does contend, however, that the Ohio court's determination of infringement by Fanner applies equally to all persons who knowingly purchase infringing products from Fanner, and that the Ohio court has jurisdiction to punish for contempt McGraw-Edison or any other person who knowingly aids and abets Fanner in violating the injunction. We agree. Non-parties may be found in contempt of an injunction provided they have actual notice of the injunction and aid or abet in its violation. See Ex parte Lennon, 1897, 166 U.S. 548, 554, 17 S.Ct. 658, 41 L.Ed. 1110, 1113; Rule 65(d) F. R. Civ. P.

The parties agree that as yet there has been no determination in the Ohio litigation of whether the "Straight-Bight Fanngrip" does or does not infringe the patent. This device first appeared on the market after final judgment was entered in the Ohio case. The question of whether it infringes the patent and violates the injunction has been raised in the Ohio court in the contempt proceedings.[7] If the Ohio court finds that the "Straight-Bight Fanngrips" infringe the patent and their production violates the injunction, Fanner will be prevented from the manufacture and sale of that product. If the Ohio court finds that the production of this product does not violate the injunction, then Preformed will be barred from contesting McGraw-Edison's right to purchase it from Fanner.

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[7]Apparently the question of whether the "Straight-Bight Fanngrip" infringes the dead end patent has also been raised in a declaratory judgment action brought by Textron against Preformed in Ohio, which has been consolidated for trial with Preformed's contempt action.

On the other hand, if the district court in this case should hold that the "Straight-Bight Fanngrip" infringes the patent, this determination would not be binding upon Fanner, the manufacturer of the product, and Fanner would still be entitled to a trial of this issue in the Ohio court. It appears accordingly that the issue should first be determined in the Ohio court, where any judgment will be binding upon the manufacturer of the product. Since its counterclaim for declaratory relief was dismissed without prejudice, McGraw-Edison may pursue any appropriate remedy it deems necessary.

We agree with appellee and the district court that "no justiciable issue is created by McGraw-Edison's plan to manufacture dead-ends independently if Fanner is unsuccessful." There is no evidence that McGraw-Edison has made any dead-ends of the type charged to infringe Preformed's patent. All dead-ends presently involved in this action, including the "Straight-Bight Fanngrips", were purchased by McGraw-Edison from The Fanner Manufacturing Company, now a division of Textron, Inc. There is "no actual controversy" with respect to any dead-ends which McGraw-Edison might plan to manufacture in the future. See Aetna Life Ins. Co. v. Haworth, 1937, 300 U.S. 227, 57 S.Ct. 461, 81 L.Ed. 617.

It is true, as appellant contends, that this court might "substitute [its] judgment for that of the court below." Delno v. Market St. Ry., supra, at 124 F.2d 968. On

the other hand, as the Supreme Court said in Kerotest Mfg. Co. v. C-O-Two Fire Equip. Co., 1952, 342 U.S. 180, 183-84, 72 S.Ct. 219, 96 L. Ed. 200, "Necessarily, an ample degree of discretion, appropriate for disciplined and experienced judges, must be left to the lower courts." While the district court might properly have permitted the counterlcaim to stand pending determination of the Ohio litigation, its dismissal under the circumstances was likewise proper. The district court did not abuse its discretion.

The judgment is affirmed.

DISMISSAL OF ACTIONS

(Rule 41 F.R.C.P.)

Rule 41. Dismissal of Actions.

* * * (2) *By Order of Court.* Except as provided in paragraph (1) of this subdivision of this rule, an action shall not be dismissed at the plaintiff's instance save upon order of the court and upon such terms and conditions as the court deemds proper. If a counterclaim has been pleaded by a defendant prior to the service upon him of the plaintiff's motion to dismiss, the action shall not be dismissed against the defendant's objection unless the counterclaim can remain pending for independent adjudication by the court. Unless otherwise specified in the order, a dismissal under this paragraph is without prejudice. * * *

SECTION 3 OF CLAYTON ACT

(15 U. S. C. § 14)

§ 14. Sale, etc., on agreement not to use goods of competitor.

It shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use, consumption, or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement, or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies, or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce. Oct. 15, 1914, c. 323, § 3, 38 Stat. 731.

DECLARATORY JUDGMENTS ACT

(28 U.S.C. § 2201 and 2202)

§ 2201. Creation of remedy.

In a case of actual controversy within its jurisdiction, except with respect to federal taxes, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal rela-

tions of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such. June 25, 1948, c. 646, 62 Stat. 964; May 24, 1949, c. 139, § 111, 63 Stat. 105; Aug. 28, 1954, c. 1033, 68 Stat. 890; July 7, 1958, Pub.L. 85-508, § 12(p), 72 Stat. 349.

§ 2202. Further relief.

Further necessary or proper relief based on a declaratory judgment or decree may be granted, after reasonable notice and hearing, against any adverse party whose rights have been determined by such judgment. June 25, 1948, c. 646, 62 Stat. 964.

PATENT ACT OF 1952

(35 U.S.C. § 282)

§ 282. Presumption of validity; defenses.

* * * The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title * * *.

PATENT ACT OF 1952

(35 U.S.C. § 102(a)(b)(e)(f)(g)

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

UNIFORM COMMERCIAL CODE OF CALIFORNIA (§ 2312)

§ 2312. Warranty of Title and Against Infringement; Buyer's Obligation Against Infringement.

* * *

(3) Unless otherwise agreed a seller who is a merchant regularly dealing in goods of the kind warrants that the goods shall be delivered free of the rightful claim of any third person by way of infringement or the like but a buyer who furnishes specifications to the seller must hold the seller harmless against any such claim which arises out of compliance with the specifications.

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In the Supreme Court of the United States

OCTOBER TERM 1966.
No. 433.

McGRAW-EDISON COMPANY,
Petitioner,

vs.

PREFORMED LINE PRODUCTS COMPANY,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT.

BRIEF IN OPPOSITION.

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TABLE OF CONTENTS.

Question Presented 1

Statute Involved 2

Supplemental Statement of the Case 2

Reasons For Denying Writ 4

Argument 6

Conclusion 15

TABLE OF AUTHORITIES.

Cases.

Aetna Casualty & Surety Co. v. Quarles, 92 F. 2d 321 (4th Cir. 1937) 8

Aetna Life Ins. Co. v. Haworth, 300 U. S. 227 (1937) 10

American Automobile Ins. Co. v. Freundt, 103 F. 2d 613 (7th Cir. 1939) 8

Brillhart v. Excess Ins. Co., 316 U. S. 491 (1942) 4, 7

Duggins v. Hunt, 323 F. 2d 746 (10th Cir. 1963) 11

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126 (1942) 14

Fanner Mfg. Co., The, v. Preformed Line Prods Co., 379 U. S. 846 (1964) 2, 3

General Talking Pictures Corp. v. Western Elec. Co., 304 U. S. 175 (1938) 13

Hammett v. Warner Bros. Pictures, Inc., 176 F. 2d 145 (2d Cir. 1949) 8

Kerotest Mfg. Co. v. C-O-Two Fire Equip. Co., 342 U. S. 180 (1952) 5, 8, 10

Kessler v. Eldred, 206 U. S. 285 (1907) 9

Lucien Lelong, Inc. v. Dana Perfumes, Inc., 138 F. Supp. 575 (N. D. Ill. 1955) 6

Mackay Radio & Tel. Co. v. Radio Corp. of America, 306 U. S. 86 (1939) ---- 14, 15
Meccano, Ltd. v. John Wanamaker, 253 U. S. 136 (1920) ---- 13
Meccano, Ltd. v. John Wanamaker, 250 Fed. 250 (2d Cir. 1918) ---- 5, 12, 13
Meccano, Ltd. v. John Wanamaker, 241 Fed. 133 (S.D.N.Y. 1917) ---- 12
Meccano, Ltd. v. Wagner, 234 Fed. 912 (S. D. Ohio 1916) ---- 12
Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Co., 315 U. S. 759 (1942) ---- 14
Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co., 324 U. S. 806 (1945) ---- 13-14
Public Affairs Associates, Inc. v. Rickover, 369 U. S. 111 (1962) ---- 4, 7
Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47 (1938) ---- 14
United States v. Bero Constr. Corp., 148 F. Supp. 295 (S.D.N.Y. 1957) ---- 6
Wagner v. Meccano Ltd., 246 Fed. 603 (6th Cir. 1917) 12
Wheeldin v. Wheeler, 280 F. 2d 293 (9th Cir. 1960) -- 11
Yellow Cab Co. v. City of Chicago, 186 F. 2d 946 (7th Cir. 1951) ---- 8

Texts.

Borchard, Declaratory Judgments 299 (2d ed. 1941) 8
5 Moore, Federal Practice ¶ 41.09, at 1101 (2d ed. 1964) ---- 6

Statute.

Federal Declaratory Judgments Act, 62 Stat. 964, 28 U. S. C. § 2201 ---- 2, 6

Federal Rules of Civil Procedure.

Rule 41(a)(2) ---- 6

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No. 433.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT.

BRIEF IN OPPOSITION.

QUESTION PRESENTED.

Petitioner has sought to interject as questions presented matters which are neither pertinent to this petition nor supported by the record. Consequently, Respondent rejects Petitioner's confused statement of the Questions Presented (Pet., pp. 2-4).* The only issue presented by the petition is:

> Whether the Court of Appeals erred in holding that the District Court properly exercised its discretion under the Declaratory Judgments Act in dis-

* The following abbreviations will be used throughout this brief:

Pet., p. __: The Petition for Writ of Certiorari.

App., p. __: The Appendix to the Petition for Writ of Certiorari.

[R. __]: The Transcript of Record.

missing without prejudice Petitioner's counterclaim "in light of the pending litigation in Cleveland, Ohio," when all of the controversies raised in the counterclaim have either been determined by or are now before the Cleveland Court.

STATUTE INVOLVED.

The statute involved is the Federal Declaratory Judgments Act, 62 Stat. 964, 28 U.S.C. § 2201, set forth at App., pp. 18-19, which reads in pertinent part:

> "[A]ny court of the United States . . . *may* declare the rights and other legal relations of any interested party seeking such declaration. . . ." (Emphasis added.)

SUPPLEMENTAL STATEMENT OF THE CASE.

Petitioner's Statement of the Case is, with one exception,* factually accurate up to the last paragraph on page 8. From that point forward, the statement is devoted to an attack on the reasoning in the Court of Appeals' opinion.

Even though the District Court dismissed this action "in light of the pending litigation in Cleveland, Ohio" [R. 226], Petitioner has omitted from its statement an adequate description of the Cleveland proceedings and the relationship of the present action to them.

Petitioner is one of many distributors of "pole line hardware" used primarily by the electrical and telephone

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* Although not germane to the issue raised in the petition, Respondent feels constrained to point out that the Cleveland District Court did not find the misuse to have been purged by "the passage of time alone" as asserted by Petitioner (Pet., p. 6). See Brief for Respondent, pp. 7-10, *The Fanner Mfg. Co. v. Preformed Line Prods Co.*, 379 U.S. 846 (1964).

industries. Respondent is a manufacturer of such hardware, one item of which is the helically shaped dead end covered by Patent No. 2,761,273. In the Cleveland litigation filed in 1956, Respondent successfully sustained the dead end patent against an infringing manufacturer, The Fanner Manufacturing Company, now a division of Textron, Inc.*

Details of the opinions of the Cleveland District Court and the Sixth Circuit are set forth in the Court of Appeals' opinion (App., p. 6). Fanner's petition for certiorari was denied by this Court. *The Fanner Mfg. Co. v. Preformed Line Prods Co.*, 379 U.S. 846 (1964).

On April 14, 1964, shortly after the Sixth Circuit decision was announced, Petitioner caused the present action to be restored to the trial calendar. Respondent stated to both The City of Los Angeles and Petitioner that since the object of this suit had been accomplished by the injunction against Fanner, Respondent was willing to dismiss this case without prejudice, in exchange for similar dismissals of their counterclaims. The City accepted this offer. Petitioner refused and pushed for early trial.

Since receipt of the mandate by the District Court in Cleveland on October 22, 1964, Fanner has continued to make and sell what it calls "Straight-Bight Fanngrips." Fanner has also continued to finance Petitioner's expenses in this action. Respondent contends that both acts constitute contempt by Fanner of the Cleveland injunction and has there raised these issues through a Motion to Punish for Contempt [R. 189] and Supplemental Motion to Punish for Contempt [R. 185].

Respondent has also charged in the Cleveland case

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* Reference to Fanner in this brief includes its successor in interest, Textron, Inc.